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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/959,575      10/28/97      CARLSON      R      1505/5A

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TM02/1220

EXAMINER

MEISLAHN, D

ART UNIT

PAPER NUMBER

2132

DATE MAILED:

12/20/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

08/959,575

Applicant(s)

Carlson

Examiner

Douglas Meislahn

Group Art Unit

2132

☒ Responsive to communication(s) filed on Oct 4, 2000

☒ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 17 and 18 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 17 and 18 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is in response to the response filed 04 October 2000. The response has overcome the 112 1<sup>st</sup> rejection.

### ***Response to Arguments***

2. Applicant's arguments filed 04 October 2000 have been fully considered but they are not persuasive.
3. With respect to the lack of enablement rejection, the examiner agrees that a person of ordinary skill in the art would be able to decide on an appropriate sample size and then, possibly based upon a cost-benefit analysis or some other arbitrary system that depends upon the perpetrator's wishes, determine the cutoff point for randomness. Since this decision will possibly be based upon a user's own wishes, applicant cannot be expected to give definitive guidelines, and, for at least this reason, the outstanding rejection is withdrawn.
4. Incidentally, alpha would be this cutoff for randomness. Alpha is the probability of type-1 error. That is, alpha is the probability of rejecting a null hypothesis even though it is true. In the instant invention, the null hypothesis is that a set of numbers are random. Also, applicant's Mendenhall citation is not currently included in the application's file.
5. Applicant's comments limiting the interpretation of "substantially" (as a safeguard against attempts to avoid infringement by circumventing literal claim language) will overcome the 112 2<sup>nd</sup> rejection if supported by case law that authorizes use of words

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like "substantially" to safeguard against nefarious behavior. Applicant has stated that this case law is abundant.

In regard to the 103 rejection, applicant first presents arguments focusing on the admitted prior art, which is functionally identical to applicant's so-called adduced prior art. Applicant states that the prior art is lacking a "systematic testing of substantially every set of numbers." This deficiency is remedied by the inclusion of the other references.

6. In response to applicant's argument that Wilke is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Wilke is concerned with random number generation in a gaming environment.

7. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

8. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the

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references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Wilke teaches the desirability of short random sets of numbers.

9. In response to applicant's argument based upon the age of the references, contentions that the reference patents are old are not impressive absent a showing that the art tried and failed to solve the same problem notwithstanding its presumed knowledge of the references. See *In re Wright*, 569 F.2d 1124, 193 USPQ 332 (CCPA 1977).

***Claim Rejections - 35 USC § 112***

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 17 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

12. The term "substantially" which is used at least thrice in claim 17 is a relative term which renders the claim indefinite. The term "substantially" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art in view of Vasseur (3309509) and Wilke et al. (4093223).

In his background section, applicant lays out the basic premise of electronic gaming. That is, clientele bet money on games of chance, wherein randomness is determined by a computer. It is apparent from the description that random number generators are employed to produce series of pseudo-random numbers. This series is composed of sets of numbers that are obviously pseudo-random in the long run. A controller is necessary to route these random numbers. Numbers are anticipated as being available upon demand for gaming purposes. Applicant's admitted prior art also says that the system must be random. Several games of chance are listed.

Applicant's admitted prior art does not say that sets from the series of random numbers must in and of themselves appear to be random. Wilke et al. present a different gaming system in which sets of random numbers are generated in a fashion that "is felt . . . [to be] sufficient . . . to insure the randomness of . . ." the variables in the sets (column 12, lines 64-65). Note that this does not actually insure that the sets of numbers are sufficiently random. Vasseur teaches, as his title says, a system for checking the random character of a sequence of symbols. This includes a verifier.

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Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply the verification system of Vasseur to the gaming engine of Wilke et al. in order to assure the system of the randomness of different sets of numbers. Sets of numbers that were not random would obviously not be used. It would have been further obvious to a person of ordinary skill in the art at the time the invention was made to apply this combined teaching of Wilke et al. and Vasseur to the electronic gaming of applicant's admitted prior art in order to allow the latter to run games such as ones anticipated by Wilke et al.

With respect to claim 18, RAM 36 of Wilke et al., mentioned in line 2 of column 13, anticipates applicant's buffer.

To summarize, the admitted prior art teaches a casino system, which probably includes more than one game of chance. The system includes substantial assurances of long-term number randomness. There is no suggestion of checking for short-term number randomness. Wilke et al. present a system that teaches the benefit of the randomness of all data sets. However, Wilke et al.'s actual method for accomplishing this is not easily compatible with the admitted prior art. Vasseur, however, teaches a system that is compatible with both Wilke et al. and the admitted prior art.

### ***Conclusion***

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Alcorn et al: (6149522).

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

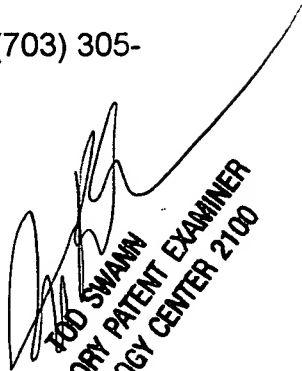
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas J. Meislahn whose telephone number is (703) 305-1338. The examiner can normally be reached between 9AM - 6PM, except for every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tod Swann can be reached on (703) 308-7791. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-9051 for regular communications and (703) 308-9052 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Douglas J. Meislahn  
Examiner  
Art Unit 2132

DJM  
December 17, 2000

  
TOD SWANN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100



FORM PTO-892		U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE		SERIAL NO. <b>08959575</b>	GROUP ART UNIT <b>2767</b>	ATTACHMENT TO PAPER NO. <b>17</b>
<b>NOTICE OF REFERENCES CITED</b>				APPLICANT(S)  <b>Carlson</b>		
<b>U.S. PATENT DOCUMENTS</b>						
*		DOCUMENT NO.	DATE	NAME	CLASS	SUB- CLASS
	A	6,149,522	11/2000	Alcorn et al.	463	29
	B					
	C					
	D					
	E					
	F					
	G					
	H					
	I					
	J					
	K					
<b>FOREIGN PATENT DOCUMENTS</b>						
*		DOCUMENT NO.	DATE	COUNTRY	NAME	SUB- CLASS
	L					
	M					
	N					
	O					
	P					
	Q					
<b>OTHER REFERENCES (Including Author, Title, Date, Pertinent Pages, Etc.)</b>						
	R					
	S					
	T					
	U					
EXAMINER <b>Douglas Meisl</b>			DATE <b>December 17, 2000</b>		Form 892ccs2106b	
A copy of this reference is not being furnished with this office action. See Manual of Patent Examining Procedure, section 707.05(a).						